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09/127,059 07/31/98 LEONARDI

A 648/1D340-US
EXAMINER

HM22/0322

ROBERT C SULLIVAN
DARBY & DARBY
805 THIRD AVENUE
NEW YORK NY 10022

BERTHARDT E PAPER NUMBER

1624
DATE MAILED:

03/22/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 2/2/00
- ☒ This action is FINAL.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-21 is/are pending in the application.
Of the above, claim(s) 6-18 is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1, 2, 4-5, 21 is/are rejected.
- ☒ Claim(s) 3, 19 and 20 is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number)
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received:

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s).
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

SEE OFFICE ACTION ON THE FOLLOWING PAGES

BEST AVAILABLE COPY

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In view of applicants' response filed 11/22/99 the following applies.

Applicants' election of group I subject matter with traverse in paper no. 8 is acknowledged but is not persuasive for the following reasons. The compounds embraced in II are not even the same compounds as in I and thus this difference alone would be sufficient to require restriction between compounds vs uses for other compounds. Even if the use claims embraced the same compounds where more than one use exists restriction is proper in accord with MPEP 806.05(h). The art applied previously and below for group I is not directed to the subject matter of II. Thus the restriction is deemed proper and is therefore made FINAL.

This application contains claims 6-18 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 1,2,4,5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Scope of "acyl", "amido" in the amended claims is unknown. Acyl broadly defined includes carbonyl as well as inorganic moieties (sulfonyl, phosphoryl, selenoyl, etc.) but specification provides no guidance as to what type of groups are considered suitable. For amido even if carboxamido was the only type contemplated the nature of groups on the nitrogen is never set forth.

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2. The same remarks made in # 1 also applies to the phraseology defining "fused heteroatom containing ring systems". The only example given in the specification of such a hetero ring fused to the benzene ring at B is benzodioxanyl. Note In re Wiggins 179 USPQ 421 regarding such terminology.

3. Recitation of halogen as a choice of substituent on the Ar rings appears to be superfluous since they are excluded by proviso (1).

A typographical error is noted in the Y definition. See "CH-OH". The "H" should be deleted.

Claims 1,2,4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Reason #1 of the previous action remains for the scope of "acyl", "amido" and hetero containing ring systems present in the claims which reads on an assortment of chemical moieties including rings having any and all types of hetero atoms for which there is no sufficient enabling disclosure.

Claims 1,2,4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Descriptive support for the fused 5- or 6-membered rings permitted at B is not seen in the original disclosure. Contrary to what applicants urge specification on p. 5

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does not describe this new genus as only benzodioxanyl is described and eg. 16 is to an indolyl. These two examples do not support the new genus which permits all degrees of unsaturation as well as any hetero atom as ring member. Also see original proviso (1).

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,2,4,5 and 21 (2nd species) remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ward for reasons of record.

Applicants urge new proviso (3) and (4) excludes subject matter taught in Ward but proviso (3) only excludes bispyridyl and proviso (4) only excludes Ar' as pyridyl. Note that Ar can also be pyridyl and thus monopyridyl at Ar/Ar' is still embraced in the claims.

Claims 1,2,4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Plilai.

While previous anticipations no longer apply, Plilai teaches a compound within the instant scope

for various pharmacological activities. See compound XII in Table 1.

Claims 3,19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Emily Bernhardt at telephone number (703) 308-4714.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

F Bernhardt

EMILY BERNHARDT
PRIMARY EXAMINER
GROUP 1200-1600